



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,374	01/05/2004	David S. Benco	LUTZ 2 00266	2674

7590 10/05/2005
Richard J. Minnich, Esq.
Fay, Sharpe, Fagan, Minnich & McKee, LLP
Seventh Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,374

Applicant(s)

BENCO ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claim(s) 26** is objected to because of the following informalities: line "claim 16" should be, "claim 18". Correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim(s) 1-11 and 17-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Tatchell et al. (US 6,160,877).

Regarding **claim(s) 1 and 17**, Tatchell discloses a method for processing a second call leg directed to a subscriber that is participating in a first call (FIGS. 9a-9f and column 1, lines 8-12), the method comprising:

receiving the second call leg directed to the subscriber (FIG. 9a and column 23, lines 18-25);

determining that the subscriber subscribes to a call answering and holding feature (FIG. 9a and column 23, lines 38-41);

determining whether the subscriber desires to place the second call leg on hold (FIG. 9a and column 23, lines 45-48);

transmitting a message to a calling party associated with the second call leg offering to place the second call leg on hold if the subscriber desires to place the second call leg on hold (FIG. 9d and column 24, lines 8-16);

receiving an indication that the calling party accepts the offer to be placed on hold if the message to the calling party is transmitted (FIG. 9d and column 24, lines 29-32);

placing the second call leg on hold if the indication that the calling party accepts the offer is received (FIG. 9d and column 24, lines 29-32); and

indicating to the subscriber that the second call leg is available, if at the time of indication, the second call leg is available (FIG. 9d and column 24, lines 41-46).

Regarding **claim(s) 2 and 18**, Tatchell discloses a method, wherein indicating to the subscriber that the second call leg is available occurs before transmitting the message to the calling party associated with the second call leg (FIG. 9d and column 23, lines 38-48).

Regarding **claim(s) 3 and 19**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold comprises: receiving an indication that the subscriber does not desire that the second call leg be placed on hold, therefore, not transmitting the message to the calling party associated with the second call leg offering to place the second call leg on hold (FIG. 9d and column 23, lines 65-67).

Regarding **claim(s) 4 and 20**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold comprises: receiving a message selection indication from the subscriber, thereby receiving an indication that the subscriber does desire that the second call leg be placed on hold (FIG. 9d and column 24, lines 8-16);

wherein transmitting the message to the calling party associated with the second call leg comprises: transmitting a customized message to the calling party based on the received message selection indication (FIG. 9d and column 24, lines 8-16).

Regarding **claim(s) 5, 21, 28 and 30**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold comprises: receiving a message selection indication from the subscriber, thereby receiving an indication that the subscriber does desire that the second call leg be placed on hold (FIG. 9d and column 24, lines 8-16);

determining an identity of the calling party (FIG. 9d and column 24, lines 1-7);

wherein transmitting the message to the calling party associated with the second call leg comprises: transmitting a customized message to the calling party based on the received message selection indication and the determined identity of the calling party (FIG. 9d and column 24, lines 8-16).

Regarding **claim(s) 6, 22 and 29**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold

comprises: determining and identity of the calling party (FIG. 9d and column 23, lines 33-46);

transmitting the determined identity of the calling party to the subscriber (FIG. 9d and column 23, lines 33-46);

receiving a message selection indication from the subscriber, thereby receiving an indication that the subscriber does desire that the second call leg be placed on hold (FIG. 9d and column 23, lines 33-46);

wherein transmitting the message to the calling party associated with the second call leg comprises: transmitting a customized message to the calling party based on the received message selection indication and the determined identity of the calling party (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 7 and 23**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold comprises: receiving information from a subscriber profile of the subscriber indicating that the subscriber desires to place on hold all second calls received while the subscriber is participating in any other call (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 8 and 24**, Tatchell discloses a method, wherein determining whether the subscriber desires to place the second call leg on hold comprises: receiving information from a subscriber profile of the subscriber indicating that the subscriber

desires to place on hold only second calls associated with potential callers included in a predefined list of potential callers (FIG. 9d and column 23, lines 33-46);

determining an identity associated with a caller associated with the second call leg (FIG. 9d and column 23, lines 33-46); and

determining if the identity associated with the caller is included in the predefined list of potential callers, thereby determining whether the subscriber desires to place the second call leg on hold (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 9, 25 and 31**, Tatchell discloses a method, wherein transmitting a customized message to the calling party based on the received message selection indication and the determined identity of the calling party comprises: receiving a list of one or more potential callers, each listed potential caller being associated with at least one predefined message, the at least one predefined message being associated with a particular message selection indication (FIG. 9d and column 23, lines 33-46);

determining that the determined identity of the calling party matches an identity of one of the listed potential callers (FIG. 9d and column 23, lines 33-46); and

transmitting a selected one of the at least one predefined messages associated with the matching listed potential caller, the selected one of the at least one predefined messages being associated with the received message selection indication from the subscriber (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 10**, Tatchell discloses a method, wherein transmitting a customized message to the calling party based on the received message selection indication and the determined identity of the calling party comprises: receiving a list of one or more predefined default messages, the one or more predefined default messages being associated with a particular message selection indication (FIG. 9d and column 23, lines 33-46);

determining that the determined identity of the calling party does not match an identity of one of the listed potential callers (FIG. 9d and column 23, lines 33-46); and

transmitting a selected one of the at least one predefined default messages, the selected one of the at least one predefined default messages being associated with the received message selection indication from the subscriber (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 11 and 26**, Tatchell discloses a method, further comprising: determining that the participation of the subscriber in the first call has ended (FIG. 9d and column 24, lines 29-46); and

connecting the second call leg to user equipment of the subscriber (FIG. 9d and column 24, lines 29-46).

Regarding **claim(s) 27**, Tatchell discloses a system for processing a second call leg directed to a subscriber that is participating in a first call (FIGS. 9a-9f and column 1, lines 8-12), the system comprising:

a profile interpreter operative to receive a subscriber profile, determine if the subscriber subscribes to a call answering and holding feature, determine settings of call answering and holding feature configuration parameters, and provide access to one or more messages stored in the subscriber profile (FIG. 9a and column 23, lines 41-45);

a subscriber interface operative to transmit information regarding the second call leg to the subscriber according to the configuration parameter setting, and to receive and interpret indications from the subscriber regarding call treatment directions (FIG. 9a and column 23, lines 45-49);

a second caller interface operative to signal a second caller associated with the second call leg according to the configuration parameters and/or the call treatment indications and to receive calling party call treatment indications from the second caller (FIG. 9d and column 24, lines 8-16); and

a hold manager operative to place the second call leg on hold according to the configuration parameters, the subscriber call treatment directions, and/or the calling party call treatment indications (FIG. 9d and column 24, lines 29-32).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim(s) 12-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tatchell in view of Revisky et al. (US 2004/0264653 A1).

Regarding **claim(s) 12**, Tatchell discloses all the limitations of **claim(s) 12** as stated in **claim(s) 1'** s rejection above and furthermore Tatchell discloses processing the second call leg without call answering and hold functions if the services provided to the subscriber do not include the call answering and holding feature (FIG. 9a and column 23, lines 32-41).

Tatchell fails to disclose receiving the second call at an MSC serving the subscriber.

However, Revisky teaches receiving the second call at an MSC serving the subscriber (FIG. 4 and paragraph 0016).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Tatchell using the communication network as taught by Revisky.

This modification of the invention enables the system to receive the second call at an MSC serving the subscriber so that the user would have access to a call waiting service on its mobile phone.

Regarding **claim(s) 13**, Tatchell discloses a method, wherein transmitting the indication to the subscriber that the second call leg is available comprises: determining an identity of a calling party associated with the second call leg (FIG. 9d and column 23, lines 33-46); and

transmitting an indication of the identity of the calling party to the subscriber (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 14**, Tatchell discloses a method, wherein transmitting the selected message comprises: determining an identity of a caller associated with the second call leg (FIG. 9d and column 23, lines 33-46); and

transmitting a message selected based on the identity of the caller and the received call treatment indication (FIG. 9d and column 23, lines 33-46).

Regarding **claim(s) 15**, Tatchell discloses a method, wherein receiving the call treatment indication comprises receiving a message based on key presses made on a keyboard of user equipment of the subscriber, thereby indicating selected message (FIG. 9d and column 23, lines 62-67).

Regarding **claim(s) 16**, Tatchell discloses a method, wherein receiving the call treatment indication comprises receiving no response from the subscriber, thereby indicating default call treatment (FIG. 9d and column 23, lines 62-67).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.
September 26, 2005

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante